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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,250	01/23/2002	Russell T. Davis	7643.0042	1920

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EXAMINER
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NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/052,250

Applicant(s)

DAVIS ET AL.

Examiner

Chau Nguyen

Art Unit

2176

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-64.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**

*12/12/2005*



Continuation of 11. does NOT place the application in condition for allowance because: In the remarks, Applicant(s) argued that

A) Saxton and Polizzi, taken alone or in combination, fail to teach or suggest "an editor that develops a report by referencing the software elements created from the one or more text documents to form a structure of the report". In reply to argument A, Polizzi discloses object includes HTML and SQL files (documents) are stored in a repository and arranged in a hierarchy or a tree system (software elements), and processing jobs that can retrieve data within a portal system (include repository) to generate reports (page 3, paragraphs [0024]-[0025]). Thus, the reports are generated or retrieved from documents stored in the repository (referencing the software elements).

B) The M.P.E.P requires that all actions on the merits issued by an Examiner "be complete and clear as to all matters." 37 C.F.R. 1.104(b), and the prior art does not teach "an editor that develops a report by referencing the software elements created from the one or more text documents to form a structure of the report". In reply to argument B, Examiner's cited the best references Saxton, Polizzi, Hamscher, and Clancey to reject claims 1-64 in the Final Office Action. Examiner's also pointed out in reply to argument A how and where Polizzi teaches "an editor... of the report". Please see the response to argument A above.

C) Applicant(s) submits that a prima facie case of obviousness has not been established. In reply to argument C, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In this case, Saxton discloses in col. 5, line 63 - col. 6, line 16 and Fig. 2a that the directory tree structure 200 provides files 224-232 and directories 201-222 in a structured hierarchy, which is similar to object files arranged in a hierarchy called categories of Polizzi, thus it would have been obvious to in the knowledge generally available to one of ordinary skill in the art at the time the invention was made to modify or combine the teachings Saxton and Polizzi since they both are from the same field of endeavor. The motivation for doing so is that Polizzi's system would allow user to configure the search to certain objects in certain locations in the hierarchy. Second, there must be a reasonable expectation of success. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the claimed invention directed to a data processing system for developing reports by referencing the software elements having a hierarchy based text documents was rejected as obvious over the reference Saxton, which taught forming a directory that contains files in a structured hierarchy (Abstract and col. 6, lines 6-16) and further in view of Polizzi reference which taught objects includes files are stored in a repository and arranged in a hierarchy or a tree system, and processing jobs that can retrieve data within a portal system (include repository) to generate reports (page 3, paragraphs [0024][0025]). Thus, there was reasonable expectation that a process combining the prior art steps could be successfully scaled up. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Please see the rejection of claim 1 in final rejection

There are no amendments to claims 1-64 in Reply to Final Office Action mailed on 11/23/2003. Therefore, Examiner's maintained the Final Office Action over Saxton, Polizzi, Hamscher and further in view of Clancey.

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
12/12/2005